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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,592	04/09/2004	Mark D. Levitt	117-P-1345USD3	1562
23322	7590	04/12/2005	EXAMINER AHMED, SHEEBA	
IPLM GROUP, P.A. POST OFFICE BOX 18455 MINNEAPOLIS, MN 55418			ART UNIT 1773	PAPER NUMBER
DATE MAILED: 04/12/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/821,592

Applicant(s)

LEVITT ET AL.

Examiner

Sheeba Ahmed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27,36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27,36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/22/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendments submitted in the above-identified application on January 5, 2005 have been entered. Claims 1 and 8 have been amended. **Claims 1-27, 36 and 37 are pending.**

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

2. Claims 1-27, are rejected under 35 U.S.C. 102(b) as being anticipated by Hamrock et al. (WO 98/11168).

The above rejection is maintained for the reasons of record as stated in the Office Action mailed on October 5, 2004.

3. Claims 1-27, 36, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Lauer et al. (US 5932,350).

Lauer et al. (US 5,932,350) disclose a method for tandem coating substrate, such as cellulosic substrates, with both highly crosslinked thermoset coatings and aqueous based coatings (Column 1, lines 1-9). The substrate may be coated first with the cured coating (ii) and then the highly crosslinked coating (i) which is preferably formed from a thermoset material that is UV curable and which before cure may be a

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high solids composition or a waterborne composition (Column 2, lines 31-51). The UV curable coatings, after exposure to UV radiation, produce highly crosslinked coatings. It has proved difficult to adhere water-based topcoats without the use of an intermediate coating (Column 3, lines 1-6). With regards to the stripability rating limitations recited in claims 7 and 16, the Examiner takes the position that such property limitations must be inherently present in the coatings taught by Lauer et al. given that the chemical composition of the coatings and the structure of the laminate as taught by Lauer et al. and as claimed in the instant application is identical. All limitations of the claimed invention are either disclosed or inherent in the above reference.

4. Claims 1-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang et al. (US 5,494,707).

Wang et al. disclose a resilient floor covering comprising of a resilient support surface and a resilient wear surface adhered to said support surface and comprising an underlying wear layer based coat and an overlying wear layer top coat adhered to said wear layer base coat (Column 3, lines 61-68). The wear layer top coat is a hard thermoset UV curable blend of acrylates (Column 4, lines 7-10). The wear layer base coat has a thickness of 0.7 to 3.0 mils and the wear layer top coat has a thickness of 0.1 to 0.5 mils (Column 8, lines 35-45). Conventional substrate layer comprises materials typical of substrate layers found in the flooring art and include vinyl compositions (Column 9, lines 59-66). With regards to the stripability rating limitations recited in claims 7 and 16, the Examiner takes the position that such property limitations must be

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inherently present in the coatings taught by Wang et al. given that the chemical composition of the coatings and the structure of the laminate as taught by Wang et al. and as claimed in the instant application is identical. All limitations of the claimed invention are either disclosed or inherent in the above reference.

Claim Rejections - 35 USC § 103

5. Claims 20, 22-27 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrock et al. (WO 98/1 1 168) in view of Holman et al. (US 6,444,134 B1).

The above rejection is maintained for the reasons of record as stated in the Office Action mailed on October 5, 2004.

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrock et al. (WO 98/11168) in view of Holman et al. (US 6,444,134 B1) and Koreltz et al. (WO 94/22965).

The above rejection is maintained for the reasons of record as stated in the Office Action mailed on October 5, 2004.

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lauer et al. (US 5932,350). in view of Koreltz et al. (WO 94/22965).

Lauer et al., as discussed above, do not state that their floor finishing system further comprises a strip agent.

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However, Koreltz et al. disclose compositions used to strip coatings such as floor finishes and/or greasy residues from surfaces such as floors and the composition is effective in removing multiple coatings comprising urethane/acrylic polymers (Page 1, lines 5-9 and Page 3, lines 35-37).

Accordingly, it would have been obvious to one having ordinary skill in the art to add the strip composition disclosed by Koreltz et al. to the floor finishing system disclosed by Lauer et al. given that such compositions can be used to remove multiple coatings.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claims 1-7, 11-16, 18, and 19 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7, 11-16, 18, and 19 of copending Application No. 10/821,560. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. The claims are identical.

Response to Arguments

9. Applicant's arguments, filed on January 5, 2005, with respect to the rejection of claims 20, 22-24, and 27 under 35 U.S.C. 102(b) as being anticipated by Bolgiano et al. (US 4,421,782) have been fully considered and are deemed persuasive. Hence, the above rejection, and any other rejections stemming from the Bolgiano reference, have been withdrawn.

Applicant's arguments filed on January 5, 2005 with respect to the rejection of claims 1-2, and 36 under 35 U.S.C. 102(b) as being anticipated by Hamrock et al. (WO 98/11168) and the rejection of claims 20, 22-27 and 37 under 35 U.S.C. 103(a) as being unpatentable over Hamrock et al. (WO 98/1 1 168) in view of Holman et al. (US 6,444,134 B1) have been fully considered but they are not persuasive. Applicants argue that the Hamrock fails to teach a waterborne topcoat. However, the Examiner would like to point out that the patentability of a product does not depend on its method of production. If the product is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). The structure implied by the process step has been considered when assessing the patentability of the claims over the prior art, however the use of a waterborne composition is not deemed to impart distinctive structural characteristics to the final product.


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Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (571)272-1504. The examiner can normally be reached on Mondays and Thursdays from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sheeba Ahmed
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March 31, 2005